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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,678	02/27/2004	Donald M. Besemer	1067.1H	7548

22886 7590 07/28/2005

AFFYMETRIX, INC
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SANTA CLARA, CA 95051

EXAMINER

HANDY, DWAYNE K

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/789,678	Applicant(s) BESEMER ET AL.	
	Examiner Dwayne K. Handy	Art Unit 1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 141-163 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 141-163 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

Handwritten signature/initials

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 141-163 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. New Claim 141 recites a method that includes the step of "assembling the array of sets of chemical reactants to the microtiter plate of test samples such that the array covers open ends in the test sample wells of the microtiter plate to form a plurality of closed cells, each closed cell comprising a set of chemical reactants and a respective test sample". Claim 153 recites a method having a similar limitation: "assembling the array onto the plate to form a sealed reaction assembly, such that the surface of the array faces the surface of plate and encloses the open ends of the plurality of wells to form closed cells, each closed cell comprising a first chemical sample and a respective set of the second chemical sample features". A similar limitation is again present in independent claims 159 and 163.

Applicant has cited page 27, lines 11-17 of the current specification as support for claim 141 (Appendix B, page 1). Applicant has cited several additional passages as

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support for claims 153, 159 and 163 (Appendix B, pages 10, 17 and 20). The Examiner respectfully disagrees with applicant that these passages provide support for the claims. The claims require that the **surface having the array** covers open ends in the well in a manner that **places the reactants of the array in the closed cell**. The Examiner believes that Applicant has provided sufficient support for an array of material on a chip. The Examiner believes that Applicant has not, however, provided any teaching in the disclosure that would place the probe material **on the side of the chip such that the material faces into the closed cavity or cell while the array surface also seals the cavity or cell**. On pages 26-27, applicant has described one embodiment in the section titled "Chip Orientation". This embodiment is shown in Figures 27a and 27b. It appears that this portion of the disclosure is the only portion which recites or shows the specific location of probes on the chip surface. Figures 27a and 27b show the chip (2790) placed into a cavity (2710) of a package (2700). The chip has probes (2795) on a surface (2791). The cavity (2710) is then sealed by a cover element (2770). While it is true that this embodiment provides a sealed cavity with an array of compounds on a substrate (chip), it does not show the cavity sealed by the array of compounds on the substrate. The cavity is instead sealed by an additional cover element on the top and by a plug or some other form of seal that closes the bottom.

Conclusion

3. The Examiner notes for the record applicant's desire to provoke an Interference with U.S. Patent No. 6,682,702 to Barth et al. based on applicant's submission of

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material on May 5, 2005. It is the Examiner's current position, however, that applicant does not have support for the new submitted claims. Therefore, the Examiner wishes to resolve the rejection under 112 1st paragraph before proceeding with an Interference.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwayne K. Handy whose telephone number is (571)-272-1259. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DKH
July 22, 2005


Jill Warden
Supervisory Patent Examiner
Technology Center 1700